

REMARKS

I. Introduction

With the cancellation herein without prejudice of claims 25 to 28, claims 13 to 24 are pending in the present application. In view of the foregoing amendments and the following remarks, it is respectfully submitted that all of the presently pending claims are allowable, and reconsideration is respectfully requested.

II. Restriction Requirement

Applicant confirms the election of claims 13 to 24. Claims 25 to 28 have been canceled herein without prejudice.

III. Rejection of Claims 13 to 24 Under 35 U.S.C. § 112, Second Paragraph

Claims 13 to 24 were rejected under 35 U.S.C. § 112, second paragraph, as allegedly indefinite. It is respectfully submitted that claims 13 to 24 are definite for at least the following reasons.

As an initial matter, the Examiner will note that claim 13 has been amended herein to change “material build-up” on line 5 to --material built-up-- to correct a typographic error.

The Office Action at page 4 asserts that the terms “the material build-up by a powder material” and “the built-up powder material” lack clarity. In this regard, page 4 of the Office Action twice poses the question, “Does the laser welding change the powder to a unitary structure or is it still powder?” However, whether “the laser welding change[s] the powder to a unitary structure” or whether “it [is] still powder” is entirely irrelevant to the question of whether the present claims comply with the definiteness requirement of 35 U.S.C. § 112, second paragraph. As set forth in M.P.E.P. § 2173.02, “[t]he essential inquiry pertaining to this requirement is whether the claims set out and circumscribe a particular subject matter with a reasonable degree of clarity and particularity,” and “[t]he test for definiteness under 35 U.S.C. 112, second paragraph, is whether ‘those skilled in the art would understand what is claimed when the claim is read in light of the specification.’” (citing Orthokinetics, Inc. v. Safety Travel Chairs, Inc., 806 F.2d 1565, 1576, 1 U.S.P.Q.2d 1081, 1088 (Fed. Cir. 1986)).

Referring, for example, to page 7, lines 16 to 22, the Specification states:

The details of laser-powder build-up welding should be familiar to the person skilled in the art addressed here. Very briefly only it should be pointed out that in laser-powder build-up welding the powder material is sprayed from a powder gun onto the substructure and that a laser beam heats the powder material such that the powder material is joined with the substructure or is built up by welding.

In view of all of the foregoing, withdrawal of this rejection is respectfully requested.

IV. Rejection of Claims 13 to 24 Under 35 U.S.C. § 103(a)

Claims 13 to 24 were rejected under 35 U.S.C. § 103(a) as unpatentable over the combination of that which the Office Action characterized as Admitted Prior Art (“the alleged APA”) and U.S. Patent No. 5,887,332 (“Champenois et al.”). It is respectfully submitted that the combination of the alleged APA and Champenois et al. does not render unpatentable the present claims for at least the following reasons.

In order for a claim to be rejected for obviousness under 35 U.S.C. § 103(a), the prior art must teach or suggest each element of the claim. See Northern Telecom, Inc. v. Datapoint Corp., 908 F.2d 931, 934 (Fed. Cir. 1990), cert. denied, 111 S. Ct. 296 (1990); In re Bond, 910 F.2d 831, 834 (Fed. Cir. 1990). In addition, as clearly indicated by the Supreme Court, it is “important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the [prior art] elements” in the manner claimed. See KSR Int’l Co. v. Teleflex, Inc., 127 S. Ct. 1727 (2007). Further, the Supreme Court in KSR noted that the analysis supporting a rejection under 35 U.S.C. 103 should be made explicit. M.P.E.P. §2143.

Claim 13 relates to a method for at least one of (a) manufacturing and (b) repairing a component for a gas turbine by laser-powder build-up welding, including, the features of performing laser-powder build-up welding using at least one substructure, *the material built-up by a powder material occurring in the laser-*

powder build-up welding such that each substructure is enclosed on all sides by the built-up powder material.

The combination of the alleged APA and Champenois et al. does not disclose, or even suggest, all of the features included in claim 13. Although the alleged APA refers generally to laser-powder build-up welding, nowhere does the alleged APA disclose enclosing a substructure on all sides by built-up powder material. Thus, the alleged APA does not disclose all of the features included in claim 13. Further, Champenois et al. merely describes depositing material onto a part 1 by use of a plasma torch, flame or electric arc, or by welding. Col. 10, lines 5 to 11. In addition, as shown in Figures 5 and 8, Champenois et al. merely describes depositing one or more separate parts, either as reinforcements on a leading edge, trailing edge, or root of a blade, or as bosses on a casing or cover. Col. 6, lines 30 to 37. Thus, nowhere does Champenois et al. disclose laser-powder build-up welding, or enclosing a substructure on all sides by built-up powder material. Thus, Champenois et al. also does not disclose all of the features included in claim 13.

Accordingly, it is respectfully submitted that the combination of the alleged APA and Champenois et al. does not disclose, or even suggest, all of the features included in claim 13. Therefore, it is respectfully submitted that the combination of the alleged APA and Champenois et al. does not render unpatentable claim 13 for at least the foregoing reasons.

As for claims 14 to 24, which ultimately depend from claim 13 and therefore include all of the features included in claim 13, it is respectfully submitted that the combination of the alleged APA and Champenois et al. does not render unpatentable these dependent claims for at least the reasons more fully set forth above.

In view of all of the foregoing, withdrawal of this rejection is respectfully requested.

V. Conclusion

It is therefore respectfully submitted that all of the presently pending claims are allowable. All issues raised by the Examiner having been addressed, an early and favorable action on the merits is earnestly solicited.

Respectfully submitted,

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